

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/801,956	FUJIMOTO ET AL.	
	Examiner	Art Unit	
	Steven C. Pohnert	1634	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: *see continuation sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The rejection of claim 74 under U.S.C. 102.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-3, 5-10, 12, 13, 17-19, 21, 26-28, 30, 35-37, 39, 44-47, 49, 52, 53, 58-61, 63, 74 and 81-96.
- Claim(s) withdrawn from consideration: \_\_\_\_\_

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_

**Attachment to Advisory**

**Continuation of box 3:** The amendments filed on 8/20/ 2007 further limit the claims to, "providing a melanoma, colon cancer or body fluid sample." These new limitations further limit the scope of the claims and thus require further search and consideration because the claims now require additional elements. Previous versions of the claims required accellular DNA, but the amended claims have a greater scope and thus require a new search.

The newly amended claim 17 requires "that the probability for a subject to suffer from a metastatic cancer is higher than the probability for the subject to suffer from primary cancer." This is a new limitation that has not previously been presented and thus would require a new search. Further the amendment appears to introduce new matter that is not supported by the specification as further discussed below. Finally the amendment would appear to introduce enablement issues as well, as it is unclear how a subject can have a higher probability of suffering from a metastatic cancer than a primary cancer, as a primary cancer is believed to be required for metastasis to occur.

The newly amended claim 26 requires "that the probability for a subject to suffer from a progressing cancer is higher than the probability for the subject to suffer from a non-progressing cancer." This is a new limitation that has not previously been presented and thus would require a new search. Further the amendment appears to introduce new matter that is not supported by the specification as further discussed below.

The newly amended claims 26, 35, 44, 58 require "providing a melanoma tissue sample or body fluid sample." This is a new limitation that has not previously been presented and thus would require a new search.

Newly amended amended claim 93 requires analysis of the markers is indicative of "breast cancer or primary or metastatic colon cancer." This new limitation has not been examined and further limits the scope of the claims. Further it appears to introduce new matter as primary or metastatic colon cancer are not recited in the specification. Further the amendment would raise 112-2<sup>nd</sup> issues as it is unclear if the claims require breast or primary breast or primary colon cancer or metastatic colon cancer.

As described above the amendment introduces many new limitations of independent claims. The response of 8/20/2007 asserts the amendments are supported through out the specification. However, the concept behind newly amended claim 17, "that the probability for a subject to suffer from a metastatic cancer is higher than the probability for the subject to suffer from primary cancer" could not be found in the specification and thus appears to be new matter. Support for claim 26, "that the probability for a subject to suffer from a progressing cancer is higher than the probability for the subject to suffer from a non-progressing cancer" could not be found in the instant specification. Support for the amendment of claim 93 to primary or metastatic colon cancer could not be found either.

The amendments are not entered because they would require a new search, raise new matter, enablement issues, as well as making the claims indefinite.

**Continuation of box 11:**

The request for reconsideration has been considered but does not place the application in condition for allowance for the reasons of record in view of the non-entry of the after final amendment.

Applicants remaining arguments refer to the amended claims and rely solely on the amendments of claims 1-3, 5, 17, 19, 21, 26-28, 30, 35-37, 39, 44-47, 49, 52-53, 58-63, 74, 81, 83-96, claims 6-8, 10, 12-13 and 81 have not been amended. The applicant provided no further arguments for claims 1-3, 5, 17-19, 21, 26-28, 30, 35-37, 39, 44-47, 49, 52-53, 58-63, 74, 81, 83-96 not already considered. Since the amendments were not entered, the arguments are moot. Therefore the arguments drawn to the after final amendments have not been considered.

The response of 8/20/2007 asserts on 17 that claims 6-8, 10, 12-13, 17-19, 21, 26-28, 30, 35-37, 39, 44-47, 49, 52-53, 58-61, 63, 74-80, 82-96 are not ambiguous. The response teaches on page that "include" means "comprise as part or whole of a group," according to the Merriam Webster online dictionary. Thus the claims rejected under the 112-2<sup>nd</sup> paragraph rejection are indefinite, because it is still unclear if the claims are limited to the recited group as consisting language would require ("whole of a group" according to Webster) or

Art Unit: 1634

encompass additional probes ("comprise part of a group" according to Webster).

Thus the claims are still indefinite and the rejection is maintained.

The response further asserts that claim 6 is enabled due to the examiner incorrect assumption that complete response meant free of melanoma. This argument has been thoroughly reviewed, but is not considered persuasive because the specification still teaches no study demonstrating that loss of all of D12S1657, D12S393, D12S1706, D12S346 is indicative of melanoma, colon cancer, or breast cancer. The studies presented in the specification appear to only study D12S1657, D12S393, D12S1706, D12S346 in patients with cancer. It would be unpredictable to associate loss of heterozygosity (LOH) examined in solely patients known to have cancer with diagnosis of cancer when the LOH of these markers has not been shown to exclusively occur in cancer and not healthy individuals. Further it is unclear how claim 6 requires the LOH of D12S1657, D12S393, D12S1706, D12S346 and indicates melanoma, and claim 93 requires that LOH of the same markers is indicative of breast or colon cancer. It appears that the claims are suggesting that LOH of D12S1657, D12S393, D12S1706, D12S346 results in cancer, without studying LOH in any healthy individuals.

The arguments with respect to claim 74 are persuasive as the claim does require acellular DNA, but the claim still stands rejected as indefinite.

The arguments for the 102 and 103 rejections all appear to be directed to the amended claims and thus are moot.

Art Unit: 1634

### Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven C. Pohnert whose telephone number is 571-272-3803. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carla Myers/  
Primary Examiner, AU 1634

A handwritten signature in black ink, appearing to read "Carla Myers", is written over the typed name.